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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,566	09/26/2003	Osamu Kanome	01272.020632	2327
5514	7590	06/30/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			FERGUSON, MARISSA L	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/670,566

Applicant(s)

KANOME ET AL.

Examiner

Marissa L Ferguson

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/8/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Kasahara (US 4,864,461).

Regarding claim 22, Kasahara teaches an insulating layer (22), a plurality of electrodes arranged alternately with positive and negative with respect to said insulating layer (4,6 and Figure 2) and a plurality of feeding terminals each of said feeding terminals connected with each of said electrodes and disposed on the side of one of longitudinal edges of said belt, said feeding terminals for feeding positive voltage extending towards one of a surface or a back of said belt, said feeding terminals for feeding negative voltage extending towards the other of said surface or said back of said belt (Column 6, Lines 46-57).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,5,11-13,25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kashara (US 4,864,461) in view of Kasahara (US 5,202,179).

Kashara teaches a base layer (20), an insulating layer on a base layer (22 and Figure 22), a plurality of electrodes arranged alternately with positive and negative with respect to said insulating layer (4,6 and Figure 2), a resin ingredient (26), a plurality of absorption layers (8,12-1,12-2) and a plurality of absorption layers including a first absorption layer directly disposed on said plurality of electrodes and a second absorption layer disposed above first absorption layer (Figures 2,7 and 8). However, he does not explicitly disclose at least two of absorption layers having different volume resistivities, said second absorption layer having a volume resistivity  $R_{a2}$  smaller than a volume resistivity  $R_{a1}$  of said first absorption layer, a volume resistivity of a resin which is a main ingredient of said second absorption layer before a control of resistance being  $1.0 \times 10^{16}$  Qcm or less.

Kasahara ('179) teaches layers with resisitvites and discloses that the resisitvity (which is inversely proportional to conductivity) of the thermoplastic material of the film of the electrodes is dependent on the amount of conductive additive added to the thermoplastic material, and that the concentration or content of the conductive additive may be varied depending on the desired end product (Column 2, lines 63-68).

However, fails a second absorption layer having a volume resistivity  $R_{a2}$  smaller than a volume resistivity  $R_{a1}$  of said first absorption layer, a volume resistivity of a resin which is a main ingredient of said second absorption layer before a control of resistance being  $1.0 \times 10^{16}$  Qcm or less.

However, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined the concentration or content of the conductive additive required to achieve the optimal resistivity of the thermoplastic material depending on the particular desired end result via routine experimentation.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention taught by Kasahara ('461) to include volume resistivities as taught by Kashara ('179), since Kashara ('179) provides a desirable and stable level of conductance.

3. Claims 2,4,6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kashara (US 4,864,461) in view of Kasahara (US 5,202,179) and Takeuchi et al. (US Patent 6,312,5430).

Kashara ('461) teaches a base layer (20), an insulating layer on a base layer (22 and Figure 22), a plurality of electrodes arranged alternately with positive and negative with respect to said insulating layer (4,6 and Figure 2), a resin ingredient (26), a plurality of absorption layers (8,12-1,12-2) and a plurality of absorption layers including a first absorption layer directly disposed on said plurality of electrodes and a second absorption layer disposed above first absorption layer (Figures 2,7 and 8). However, he does not explicitly disclose at least two of absorption layers having different volume resistivities, said second absorption layer having a volume resistivity  $R_{a2}$  smaller than a

volume resistivity Ra1 of said first absorption layer, a volume resistivity of a resin which is a main ingredient of said second absorption layer before a control of resistance being  $1.0 \times 10^{16}$  Qcm or less, a fluoride resin outer layer and a means for transferring an image.

Kasahara ('179) teaches layers with resistivities and discloses that the resistivity (which is inversely proportional to conductivity) of the film of the electrodes is dependent on the amount of conductive additive added to a thermoplastic material, and that the concentration or content of the conductive additive may be varied depending on the desired end product (col. 2, lines 63-68). However, he does not explicitly disclose a layer of fluoride resin. Takeuchi et al. teaches an outer layer of resin (Column 3, Lines 16-20) with fluororesin (Column 4, Lines 20-30 and Column 6, Lines 63-67) and a means for transferring a print medium (Column 2, Lines 24-35).

However, he does not disclose a second absorption layer having a volume resistivity Ra2 smaller than a volume resistivity Ra1 of said first absorption layer, a volume resistivity of a resin which is a main ingredient of said second absorption layer before a control of resistance being  $1.0 \times 10^{16}$  Qcm or less.

However, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined the concentration or content of the conductive additive required to achieve the optimal

resistivity of the thermoplastic material depending on the particular desired end result via routine experimentation.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention taught by Kasahara ('461) to include volume resistivities as taught by Kashara ('179), since Kashara ('179) provides a desirable and stable level of conductance and to further modify Kasahara('461) to include an outer fluoride resin layer and transferring an image as taught by Takeuchi et al., since Takeuchi et al. provides the layer in order to assist in the strengthening of bonding layers and to improve physical characteristics of a image.

4. Claims 7-10,15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. (US Patent 6,312,5430) in view of Kasahara (US 5,202,179).

Takeuchi et al. teaches winding a base layer sheet on a core member so that the both ends of said base layer sheet overlap with each other ,winding an insulating layer sheet on said base layer sheet, said insulating layer sheet having a plurality of openings ,winding a first sheet for an absorption layer on said insulating layer sheet so that the both ends of said first sheet overlap with each other , winding a second sheet for said absorption layer on said first sheet so that the both ends of said second sheet overlap with each other (Abstract, Columns 3,4 and reference made throughout patent), covering a circumferential surface of said second sheet with a cylindrical member (Figure 4 and reference made throughout patent) and thermally joining adjacent sheets and said overlapped portions (Column 2, Lines 17-23 and reference made throughout prior art). However, he does not explicitly disclose

disposing an electrode sheet and a second sheet having a volume resistivity  $R_{a2}$  smaller than a volume resistivity  $R_{a1}$  of said first sheet, a volume resistivity of a resin which is a main ingredient of said second sheet before a control of resistance being  $1.0 \times 10^{16} \Omega\text{cm}$  or less.

Kasahara teaches an electrostatic device with an electrode sheet (Column 4, Lines 19-36) and a resistivity (which is inversely proportional to conductivity) of the thermoplastic material of the film of the electrodes is dependent on the amount of conductive additive added to the thermoplastic material, and that the concentration or content of the conductive additive may be varied depending on the desired end product (col. 2, lines 63-68). Kasahara, he does not disclose a second absorption layer having a volume resistivity  $R_{a2}$  smaller than a volume resistivity  $R_{a1}$  of said first absorption layer, a volume resistivity of a resin which is a main ingredient of said second absorption layer before a control of resistance being  $1.0 \times 10^{16} \Omega\text{cm}$  or less.

However, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined the concentration or content of the conductive additive required to achieve the optimal resistivity of the thermoplastic material depending on the particular desired end result via routine experimentation.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention taught by Takeuchi et al. to include



the electrodes and volume resistivities as taught by Kashara ('179), since Kashara ('179) provides a desirable and stable level of conductance between the electrodes.

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kashara (US 4,864,461) in view of Takeuchi et al. (US Patent 6,312,5430).

Kashara teaches the invention claimed, however he does not explicitly disclose a means for transferring a print medium. Takeuchi et al. discloses a means for transferring a print medium (Column 2, Lines 24-35). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention taught by Kasahara ('461) to include transferring an image as taught by Takeuchi et al., since Takeuchi et al. teaches transferring an image in order to improve physical characteristics of a image.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. (US Patent 6,312,5430) in view of Kasahara (US 5,202,179) and Miyaguchi et al. (US 6,708,014)

Takeuchi et al. teaches winding a base layer sheet on a core member so that the both ends of said base layer sheet overlap with each other ,winding an insulating layer sheet on said base layer sheet, said insulating layer sheet having a plurality of openings ,winding a first sheet for an absorption layer on said insulating layer sheet so that the both ends of said first sheet overlap with each other , winding a second sheet for said absorption layer on said first sheet so that the both ends of said second sheet overlap with each other (Abstract, Columns 3,4 and reference made throughout patent), covering a circumferential surface of said second sheet with a

cylindrical member (Figure 4 and reference made throughout patent) and thermally joining adjacent sheets and said overlapped portions (Column 2, Lines 17-23 and reference made throughout prior art). However, he does not explicitly disclose disposing an electrode sheet and a second sheet having a volume resistivity  $R_{a2}$  smaller than a volume resistivity  $R_{a1}$  of said first sheet, a volume resistivity of a resin which is a main ingredient of said second sheet before a control of resistance being  $1.0 \times 10^{16} \Omega\text{cm}$  or less and a lamination method.

Kasahara teaches an electrostatic device with an electrode sheet (Column 4, Lines 19-36) and a resistivity (which is inversely proportional to conductivity) of the thermoplastic material of the film of the electrodes is dependent on the amount of conductive additive added to the thermoplastic material, and that the concentration or content of the conductive additive may be varied depending on the desired end product (col. 2, lines 63-68). Miyaguchi et al. teaches laminating a layer (Column 11, Lines 44-54) on a base. Kasahara does not disclose a second absorption layer having a volume resistivity  $R_{a2}$  smaller than a volume resistivity  $R_{a1}$  of said first absorption layer, a volume resistivity of a resin which is a main ingredient of said second absorption layer before a control of resistance being  $1.0 \times 10^{16} \Omega\text{cm}$  or less. Kashara does not teach a lamination method.

However, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined

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the concentration or content of the conductive additive required to achieve the optimal resistivity of the thermoplastic material depending on the particular desired end result via routine experimentation.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention taught by Takeuchi et al. to include the electrodes and volume resistivities as taught by Kashara ('179), since Kashara ('179) provides a desirable and stable level of conductance between the electrodes and to further modify Takeuchi et al. to include a lamination layer as taught by Miyaguchi et al., since Miyaguchi et al. teaches using a laminate to efficiently bond a film to a base layer.

### ***Conclusion***

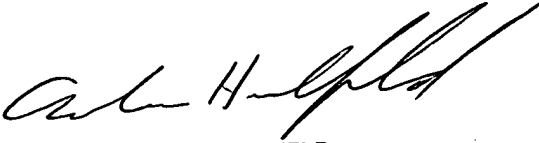
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L Ferguson whose telephone number is (571) 272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other(F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marissa L Ferguson  
Examiner  
Art Unit 2854

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